REMARKS

This Amendment is filed in response to the Office Action dated August 5, 2004, which has a shortened statutory period set to expire November 5, 2004. A two-month extension, extending the period of response until January 5, 2005, is requested in a petition filed herewith.

Double Patenting Rejections

Claims 1-3, 5-6, 14-16, and 18-19 stand rejected under the judicially created doctrine of double patenting over Claims 1-9 of co-owned U.S. Patent No. 6,675,305. Claims 4, 7, 8-10, 11-13, and 21-23 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-9 of co-owned U.S. Patent No. 6,675,305 in view of U.S. Patent No. 5,742,603, issued April 21, 1998 to Shafir et al. (hereinafter "Shafir"), and apparently in view of U.S. Patent Application Serial No. 10/168,706, filed by Yik et al. on December 18, 2000 (hereinafter "Yik"). Claims 9, 13, and 22 are cancelled, rendering the rejection of those claims moot. Without making any statement as to the validity of the remaining rejections, Applicant submits herewith a terminal disclaimer to advance prosecution of the present application. As noted by the Federal Circuit:

> In legal principle, the filing of terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither presumption nor estoppel on the merits of the rejection. It is improper to convert this simple expedient of "obviation" into an admission or acquiescence or estoppel on the merits. Quad Environmental Technologies Corp. v. Union Sanitary Dist., 946 F.2d 870, 874, 20 USPQ2d 1392, 1394-95 (Fed. Cir. 1991).

Accordingly, Applicant respectfully requests
reconsideration and withdrawal of the double patenting
rejections of Claims 1-8, 10-12, 14-16, 18-19, 21, and 23.

(SN: 09/910,171)

Rejections Under 35 U.S.C. 102

Claims 1-2, 4-6, 8, 10, 14-15, 17-19, 21, and 23 stand rejected under 35 U.S.C. 102(e) as being anticipated by Yik. Applicant respectfully traverses these rejections in light of the above amendments and the following remarks.

Claim 1, as amended, recites, "detecting that an operation on **a control and status register/remote monitor counter (CSR/RMON) block** is needed [and] enabling a clock signal to the CSR/RMON block." (Emphasis added.) Support for this amendment is found in the specification as originally filed at least at page 5, line 9 through page 6, line 6. Claims that depend from Claim 1 are amended as necessary to maintain consistency with amended Claim 1. No new matter is added. "[D]etecting that an operation on a [CSR/RMON] block is needed [and] enabling a clock signal to the CSR/RMON block" as recited in Claim 1 can beneficially save power in a media access controller (MAC) since "programming and reading of the registers and counters [in the CSR/RMON block] accounts for only about 20% to 25% of the total time the media access controller is active." (Specification as originally filed, page 1, lines 20-21.)

Yik only describes the a system in which "**the receive logic and the transmit logic of the MAC controller 100 are activated** in response to the detection of either a receive event or a transmit event." (Yik, paragraph 14.) (Emphasis added.) Nowhere does Yik disclose "[D]etecting that an operation on a [CSR/RMON] block is needed [and] enabling a clock signal to the CSR/RMON block" as recited in Claim 1. As is known in the art, a CSR/RMON block includes:

> [c]ontrol registers [to] store different parameters required to implement core functionality of the media access controller[, s]tatus registers [to] store event information which occurs on the Ethernet cable[, and r]emote monitor counters [to] store packet statistics that

are updated by the media access controller core.
(Specification as originally filed, page 1, lines 12-16.)

Accordingly, and as is known in the art, the CRS/RMON block of a
MAC operates separately from the general transmit/receive logic
that processes outgoing/incoming data packets. Therefore,
"enabling a clock signal to the CSR/RMON block" as needed (as
recited in Claim 1), beneficially reduces power consumption in a
manner not disclosed or suggested by Yik.

For at least this reason, Claim 1 is allowable over Yik
under 35 U.S.C. 102(e). Claims 2 and 4-6 depend from Claim 1,
and are therefore allowable over Yik for at least the same
reasons that Claim 1 is allowable. Accordingly, reconsideration
and allowance of Claims 1, 2, and 4-6 is respectfully requested.

Claim 8 is amended to recite:

A method for **reading one of a status register and a
remote monitor counter in a control and status
register/remote monitor and counter (CSR/RMON) block** in a
media access control component comprising the steps of []
detecting an update to the one of the status register and
the remote monitor counter [and] providing a clock signal
to the one of the status register and the remote monitor
counter in response to detection of the update. (Emphasis
added.)

Support for this amendment is found in the specification as
originally filed at least at page 5, line 9 through page 6, line
6. Claims that depend from Claim 8 are amended as necessary to
maintain consistency with amended Claim 8. No new matter is
added.

For reasons similar to those described above with respect
to Claim 1, Yik does not disclose "providing a clock signal to
the one of the status register and the remote monitor counter
[in the CSR/RMON block] in response to detection of the update"
as recited in Claim 8. Thus, for at least this reason, Claim 8
is allowable over Yik under 35 U.S.C. 102(e). Claim 10 depends

10   (SN: 09/910,171)

from Claim 8, and is therefore allowable over Yik for at least the same reasons that Claim 8 is allowable. Accordingly, reconsideration and allowance of Claims 8 and 10 is respectfully requested.

Claim 14, as amended, recites:

> [A] detection unit that detects that an operation on a control and status register/remote monitor counter (CSR/RMON) block is needed [and] **a clock enable unit that enables a clock signal to the CSR/RMON block in response to a detection that the operation is needed.** (Emphasis added.)

Support for this amendment is found in the specification as originally filed at least at page 5, line 9 through page 6, line 6. Claims that depend from Claim 14 are amended as necessary to maintain consistency with Claim 14. No new matter is added.

For reasons similar to those described above with respect to Claim 1, Yik does not disclose "a clock enable unit that enables a clock signal to the CSR/RMON block in response to a detection that the operation is needed" as recited in Claim 14. Thus, for at least this reason, Claim 14 is allowable over Yik under 35 U.S.C. 102(e). Claims 15 and 17-19 depend from Claim 14, and are therefore allowable over Yik for at least the same reasons that Claim 14 is allowable. Accordingly, reconsideration and allowance of Claims 14-15 and 17-19 is respectfully requested.

Claim 21, as amended, recites:

> [C]lock gating logic that detects that an operation on the CSR/RMON block is to be performed and **enables a clock signal to the CSR/RMON block in response to a detection that an operation is to be performed.** (Emphasis added.)

Support for this amendment is found in the specification as originally filed at least at page 5, line 9 through page 6, line 6. Claims that depend from Claim 21 are amended as necessary to maintain consistency with Claim 21. Claim 23 is amended to

correct an inadvertent and obvious clerical error (referencing incorrect claim). No new matter is added.

For reasons similar to those described above with respect to Claim 1, Yik does not disclose "enables a clock signal to the CSR/RMON block in response to a detection that an operation is to be performed" as recited in Claim 21. Thus, for at least this reason, Claim 21 is allowable over Yik under 35 U.S.C. 102(e). Claim 23 depends from Claim 21, and is therefore allowable over Yik for at least the same reasons that Claim 21 is allowable. Accordingly, reconsideration and allowance of Claims 21 and 23 is respectfully requested.

Rejections Under 35 U.S.C. 103

Claims 3, 7, 9, 16, 20, and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yik in view of Shafir. Claims 9 and 22 are cancelled, rendering the rejection of those claims moot. Applicant respectfully traverses the rejections of Claims 3, 7, 16, and 20 in light of the above amendments and the following remarks.

Claims 3 and 7 depend from Claim 1. As noted above, Yik does not teach "[D]etecting that an operation on a [CSR/RMON] block is needed [and] enabling a clock signal to the CSR/RMON block". Shafir does not remedy this deficiency of Yik. Shafir does mention the existence of "RMON counters 220" (Shafir, col. 4, line 28), but provides no indication of power consumption requirements or concerns for a CSR/RMON block. Thus, for at least this reason, Claims 3 and 7 are allowable over Yik in view of Shafir. Applicant therefore respectfully requests reconsideration and allowance of Claims 3 and 7.

Claims 16 and 20 depend from Claim 14. As noted above, Yik does not teach "a clock enable unit that enables a clock signal to the CSR/RMON block in response to a detection that the operation is needed" as recited in Claim 14. Shafir does not remedy this deficiency of Claim 14. Thus, for at least this reason, Claims 16 and 20 are allowable over Yik in view of Shafir. Applicant therefore respectfully requests reconsideration and allowance of Claims 16 and 20.

CONCLUSION

Claims 1-8, 10-12, 14-21, and 23 are pending in the present Application. Reconsideration and allowance of these claims is respectfully requested.

If there are any questions, please telephone the undersigned at (408) 451-5903 to expedite prosecution of this case.

Respectfully submitted,

Customer No.: 35273

John M. Kubodera
Attorney for Applicant(s)
Reg. No. 45,984

I hereby certify that this correspondence is being deposited with the United States Postal Service as FIRST CLASS MAIL in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 4, 2005.

1/4/2005
Date

Signature: Rebecca A. Baumann

(SN: 09/910,171)